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14 UNITED STATES DISTRICT COURT

15 SOUTHERN DISTRICT OF CALIFORNIA

17 GEN-PROBE INCORPORATED,

18 Plaintiff,

19 v.

20 VYSIS, INC.,

21 Defendant.

No. 99cv2668 H (AJB)

**GEN-PROBE INCORPORATED'S OBJECTIONS
AND RESPONSES TO VYSIS, INC.'S THIRD SET
OF INTERROGATORIES, NOS. 10 & 11**

23 **PROPOUNDING PARTY: DEFENDANT VYSIS, INC.**

24 **RESPONDING PARTY: PLAINTIFF GEN-PROBE INCORPORATED**

25 **SET NUMBER: THREE (3)**

26 Pursuant to Federal Rule of Civil Procedure 33, Plaintiff Gen-Probe Incorporated ("Gen-
27 Probe") responds as follows to Defendant Vysis, Inc.'s ("defendant") third set of interrogatories
28 Nos. 10 and 11:

1 **I. GENERAL RESPONSES.**

2 1. Gen-Probe's response to defendant's third set of interrogatories is made to the best of
3 Gen-Probe's present knowledge, information, and belief. Said response is at all times subject to
4 such additional or different information that discovery or further investigation may disclose and,
5 while based on the present state of Gen-Probe's recollection, is subject to such refreshing of
6 recollection, and such additional knowledge of facts, as may result from Gen-Probe's further
7 discovery or investigation. Gen-Probe reserves the right to make any use of, or to introduce at any
8 hearing and at trial, information and/or documents responsive to defendant's first set of
9 interrogatories but discovered subsequent to the date of this response, including, but not limited to,
10 any such information or documents obtained in discovery herein.

11 2. To the extent that Gen-Probe responds to defendant's interrogatories by stating that
12 Gen-Probe will provide information and/or documents which Gen-Probe, any other party to this
13 litigation, or any other person or entity deems to embody material that is private, business
14 confidential, proprietary, trade secret, or otherwise protected from disclosure pursuant to Federal
15 Rule of Civil Procedure 26(c)(7), Federal Rule of Evidence 501, California Evidence Code section
16 1060, or California Constitution, article I, section 1, or any like or similar provision of law of any
17 jurisdiction Gen-Probe will do so only upon the entry of an appropriate protective order against the
18 unauthorized use or disclosure of such information.

19 3. Gen-Probe reserves all objections or other questions as to the competency, relevance,
20 materiality, privilege or admissibility as evidence in any subsequent proceeding in or trial of this or
21 any other action for any purpose whatsoever of Gen-Probe's responses herein and any document or
22 thing identified or provided in response to defendant's interrogatories.

23 4. Gen-Probe reserves the right to object on any ground at any time to such other or
24 supplemental interrogatories as defendant may at any time propound involving or relating to the
25 subject matter of these interrogatories.

26 **II. GENERAL OBJECTIONS.**

27 1. Gen-Probe makes the following general objections, whether or not separately set forth
28 in response to each interrogatory, to each instruction, definition, and interrogatory made in

1 defendant's first set of interrogatories:

2 2. Gen-Probe objects generally to interrogatories 10 and 11, insofar as they seek
3 information or production of documents protected by the attorney-client or the attorney work
4 product privilege. Such information or documents shall not be provided in response to defendant's
5 interrogatories and any inadvertent disclosure or production thereof shall not be deemed a waiver
6 of any privilege with respect to such information or documents or of any work product immunity,
7 which may attach thereto.

8 3. Gen-Probe objects generally to each interrogatory to the extent it seeks to require Gen-
9 Probe to identify in this response each or any document or other information which may relate to,
10 reflect or otherwise refer to specified matters on the ground that such requests collectively
11 encompass potentially thousands of pages of documents not all of which have or can be located
12 and reviewed by counsel within the time period allowed by statute for this response. Accordingly,
13 said request would subject Gen-Probe to unreasonable and undue annoyance, oppression, burden,
14 and expense.

15 4. Gen-Probe objects to Definition B to the extent it defines "Gen-Probe" to include Gen-
16 Probe's predecessors or successors; past or present divisions, subsidiaries, parents, or affiliates of
17 any of the foregoing entities; past or present joint ventures, partnerships, or limited partnerships of
18 which any of the foregoing entities is a joint venturer or a limited or general partner; and past or
19 present directors, officers, employees, agents, or representatives of any of the foregoing entities.
20 Said definition is vague and ambiguous in that it cannot be determined what is meant by the term
21 "Gen-Probe." Said definition is also overly broad, seeks irrelevant information not calculated to
22 lead to the discovery of admissible evidence, and would subject Gen-Probe and the other entities
23 identified in the definition to unreasonable and undue annoyance, oppression, burden and expense.

24 5. Gen-Probe objects to the introductory statement to the extent it suggests that the
25 interrogatories are continuing, on the ground that said instruction seeks unilaterally to impose an
26 obligation to provide supplemental information greater than that required by Federal Rule of Civil
27 Procedure 26(e) and would subject it to unreasonable and undue annoyance, oppression, burden,
28 and expense. Gen-Probe will comply with the requirements of the Federal Rules of Civil

1 Procedure and is willing to discuss mutually acceptable reciprocal obligations of defendant for
2 continuing discovery.

3 6. Gen-Probe objects to Instruction A to the extent it seeks to require Gen-Probe to
4 identify anything other than the specific claim or privilege or work product being made and the
5 basis for such claim, on the ground that the additional information sought by defendant would
6 subject Gen-Probe to unreasonable and undue annoyance, oppression, burden, and expense, and
7 constitutes information protected from discovery by privilege and as work product.

8 **III. SPECIFIC OBJECTIONS AND RESPONSES TO INTERROGATORIES.**

9 Without waiving or limiting in any manner any of the foregoing General Objections, but
10 rather incorporating them into each of the following responses to the extent applicable, Gen-Probe
11 responds to the specific interrogatories in defendant's first set of interrogatories as follows:

12 **INTERROGATORY NO. 10:**

13 State each factual and legal basis for Gen-Probe's contention that the form of target capture
14 used by its nucleic acid tests for the detection of HIV and HCV in donated blood and blood
15 products is not disclosed or claimed in the '338 patent, as set forth in Gen-Probe's response to
16 Interrogatory No. 4.

17 **RESPONSE TO INTERROGATORY NO. 10:**

18 Gen-Probe incorporates into this response each of the foregoing General Responses and
19 General Objections as if fully set forth herein. Gen-Probe objects to this interrogatory on the
20 grounds that it seeks information that is not relevant to the subject matter of this lawsuit in view of
21 the Court's June 20, 2001 "Order Granting Motion for Partial Summary Judgment of Non-
22 Infringement of the '338 Patent; Claim Construction of the term "Amplifying" as found in the '338
23 Patent."

24 Subject to all of the foregoing, Gen-Probe states that it's method of target capture has been
25 found to be patentably distinct from the prior art, including the '338 patent, by the U.S. Patent and
26 Trademark Office (see U.S. Patent No. 6,110,678).

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1 **INTERROGATORY NO. 11:**

2 State whether Gen-Probe contends that its transcription mediated amplification (TMA)
3 technique does not amplify the target polynucleotide as disclosed and claimed in the '338 Patent,
4 and, if so, state each factual and legal basis for that contention.

5 **RESPONSE TO INTERROGATORY NO. 11:**

6 Gen-Probe incorporates into this response each of the foregoing General Responses and
7 General Objections as if fully set forth herein. Gen-Probe objects to this interrogatory on the
8 grounds that it seeks information that is not relevant to the subject matter of this lawsuit in view of
9 the Court's June 20, 2001 "Order Granting Motion for Partial Summary Judgment of Non-
10 Infringement of the '338 Patent; Claim Construction of the term "Amplifying" as found in the '338
11 Patent."

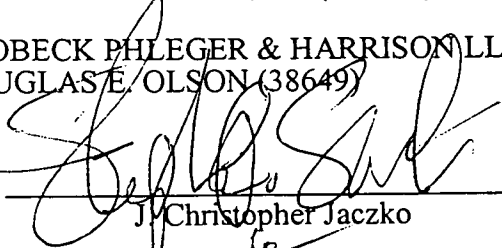
12 State whether Gen-Probe contends that its transcription mediated amplification (TMA)
13 technique does not amplify the target polynucleotide as disclosed and claimed in the '338 Patent,
14 and, if so, state each factual and legal basis for that contention.

15 Dated: June 29, 2001

16 COOLEY GODWARD LLP
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J. CHRISTOPHER JACZKO (149317)

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18 R. WILLIAM BOWEN, JR. (102178)

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21 By: 
22 J. Christopher Jaczko

23 Attorneys for Plaintiff
24 Gen-Probe Incorporated

PROOF OF SERVICE
(FRCP 5)

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3 I am a citizen of the United States and a resident of the State of California. I am employed
4 in San Diego, State of California, in the office of a member of the bar of this Court, at whose
5 direction the service was made. I am over the age of eighteen years, and not a party to the within
6 action. My business address is 4365 Executive Drive, Suite 1100, San Diego, California 92121-
7 2128. On the date set forth below I served the documents described below in the manner described
8 below:

9 **1. GEN-PROBE INCORPORATED'S OBJECTIONS AND RESPONSES TO VYSIS, INC.'S THIRD
10 SET OF INTERROGATORIES, NOS. 10 & 11**

11 (BY U.S. MAIL) I am personally and readily familiar with the business practice of
12 Cooley Godward llp for collection and processing of correspondence for mailing
13 with the United States Postal Service, and I caused such envelope(s) with postage
14 thereon fully prepaid to be placed in the United States Postal Service at Palo Alto,
15 California.

16 (BY MESSENGER SERVICE) by consigning the document(s) to an authorized
17 courier and/or process server for hand delivery on this date. See attached Proof of
18 Personal Service.

19 (BY FACSIMILE) I am personally and readily familiar with the business practice
20 of Cooley Godward llp for collection and processing of document(s) to be
21 transmitted by facsimile and I caused such document(s) on this date to be
22 transmitted by facsimile to the offices of addressee(s) at the numbers listed below.
(No Exhibits Attached.)

23 (BY OVERNIGHT MAIL) I am personally and readily familiar with the business
24 practice of Cooley Godward llp for collection and processing of correspondence for
25 overnight delivery, and I caused such document(s) described herein to be deposited
26 for delivery to a facility regularly maintained by Federal Express for overnight
27 delivery.

28 on the following part(ies) in this action:

Exhibit A, Page 6

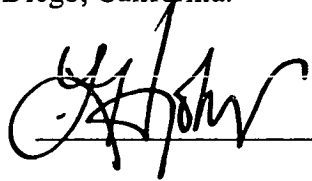
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Executed on June 29, 2001, at San Diego, California.



Liz Hoke